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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,188	09/24/2003	David Bennett Anderson	X-5683K	5066
25885	7590	05/21/2004	EXAMINER	
ELI LILLY AND COMPANY PATENT DIVISION P.O. BOX 6288 INDIANAPOLIS, IN 46206-6288			WEDDINGTON, KEVIN E	
			ART UNIT	PAPER NUMBER
			1614	

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/670,188	<b>Applicant(s)</b> ANDERSON ET AL.	
	<b>Examiner</b> Kevin E. Weddington	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

CLAIMS 5-8 ARE PRESENTED FOR EXAMINATION.

APPLICANTS' RESPONSE FILED APRIL 26, 2004 HAS BEEN RECEIVED AND ENTERED.

ACCORDINGLY, THE REJECTION MADE UNDER 37 CFR 1.178 FOR THE FAILURE TO SURRENDER THE ORIGINAL RIBBONED U.S. PATENT GRANT AS SET FORTH IN THE PREVIOUS OFFICE ACTION AT PAGE 2 IS HEREBY WITHDRAWN.

*DOUBLE PATENTING*

A REJECTION BASED ON DOUBLE PATENTING OF THE "SAME INVENTION" TYPE FINDS ITS SUPPORT IN THE LANGUAGE OF 35 U.S.C. 101 WHICH STATES THAT "WHOEVER INVENTS OR DISCOVERS ANY NEW AND USEFUL PROCESS ... MAY OBTAIN A PATENT THEREFOR ..." (EMPHASIS ADDED). THUS, THE TERM "SAME INVENTION," IN THIS CONTEXT, MEANS AN INVENTION DRAWN TO IDENTICAL SUBJECT MATTER. SEE *MILLER V. EAGLE MFG. CO.*, 151 U.S. 186 (1894); *IN RE OCKERT*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); AND *IN RE VOGEL*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A STATUTORY TYPE (35 U.S.C. 101) DOUBLE PATENTING REJECTION CAN BE OVERCOME BY CANCELING OR AMENDING THE CONFLICTING CLAIMS SO THEY ARE NO LONGER COEXTENSIVE IN SCOPE. THE FILING OF A TERMINAL DISCLAIMER CANNOT OVERCOME A DOUBLE PATENTING REJECTION BASED UPON 35 U.S.C. 101.

CLAIMS 5-8 ARE AGAIN REJECTED UNDER 35 U.S.C. 101 AS CLAIMING THE SAME INVENTION AS THAT OF CLAIMS 1-4 OF PRIOR U.S. PATENT No. 5,631,298.

THE PRESENT APPLICATION AND THE PATENTED APPLICATION ARE CLAIMING THE SAME INVENTION.

A COMPOSITION USEFUL FOR TREATING A DOMESTICATED WARM-BLOODED ANIMAL TO PROMOTE GROWTH IMPROVE FEED EFFICIENCY, OR IMPROVE LEANNESS COMPRISING (1) BETA-PHENETHANOLAMINES OF FORMULA I AND (2) A SECOND COMPOUND SELECTED FROM A TETRACYCLINE, TYLSOIN, PENICILLIN, CEPHALOSPORIN, POLYETHER, GLYCOPEPTIDE, OR ORTHOSOMYCIN, IN A RATION OF ABOUT 1 TO ABOUT 2 PARTS BY WEIGHT OF THE FIRST COMPOUND AND ABOUT 1 TO ABOUT 10 PARTS BY WEIGHT OF THE SECOND COMPOUND.

THIS IS A DOUBLE PATENTING REJECTION.

CLAIMS 5-8 ARE NOT ALLOWED.

*CONCLUSION*

THIS ACTION IS MADE FINAL. APPLICANT IS REMINDED OF THE EXTENSION OF TIME POLICY AS SET FORTH IN 37 CFR 1.136(A).


A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO KEVIN E. WEDDINGTON WHOSE TELEPHONE NUMBER IS (571) 272-0587. THE EXAMINER CAN NORMALLY BE REACHED ON 11:00 AM-7:30 PM.

IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, MARRIANNE SEIDEL CAN BE REACHED ON (703) 308-1235. THE FAX PHONE NUMBER FOR THE ORGANIZATION WHERE THIS APPLICATION OR PROCEEDING IS ASSIGNED IS 703-872-9306.

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INFORMATION REGARDING THE STATUS OF AN APPLICATION MAY BE OBTAINED FROM THE PATENT APPLICATION INFORMATION RETRIEVAL (PAIR) SYSTEM. STATUS INFORMATION FOR PUBLISHED APPLICATIONS MAY BE OBTAINED FROM EITHER PRIVATE PAIR OR PUBLIC PAIR. STATUS INFORMATION FOR UNPUBLISHED APPLICATIONS IS AVAILABLE THROUGH PRIVATE PAIR ONLY. FOR MORE INFORMATION ABOUT THE PAIR SYSTEM, SEE [HTTP://PAIR-DIRECT.USPTO.GOV](http://PAIR-DIRECT.USPTO.GOV). SHOULD YOU HAVE QUESTIONS ON ACCESS TO THE PRIVATE PAIR SYSTEM, CONTACT THE ELECTRONIC BUSINESS CENTER (EBC) AT 866-217-9197 (TOLL-FREE).

  
KEVIN E. WEDDINGTON  
PRIMARY EXAMINER  
ART UNIT 1614

K. WEDDINGTON  
MAY 18, 2004